IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#10 6/27/03

Re. Appellant:	Thomas C. Mielenhausen
Serial No.:	09/309,831
Filed:	May 11, 1999
For:	DATA PROCESSING APPARATUS AND METHOD FOR CONVERTING WORDS TO ABBREVIATIONS, CONVERTING ABBREVIATIONS TO WORDS, AND SELECTING ABBREVIATIONS FOR INSERTION INTO TEXT
Examiner:	Cong Lac T Huynh
Group:	2178
Confirmation No.:	8013
Attorney:	Nelson R. Capes
Attorney Docket No.:	33197.8
Additional Fees:	Charge to Deposit Account 023732

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICANT'S APPEAL BRIEF

Applicant by his attorney submits three copies of this Appeal Brief, pursuant to the Office Action mailed March 6, 2003 and 37 C.F.R. § 1.192 in further of the Appeal, the notice of which was filed with the United States Patent and Trademark Office on May 5, 2003.

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

By Nelson R. Capes
Date 6/19/03

I. REAL PARTY IN INTEREST

The real party in interest is Thomas C. Mielenhausen, the inventor.

II. RELATED APPEALS AND INTERFERENCES

Applicant is unaware of any related appeals or interferences.

III. STATUS OF CLAIMS

The claims on appeal are claims 1-22.

IV. STATUS OF AMENDMENTS

No amendments have been made after the final rejection dated March 6, 2003.

V. SUMMARY OF THE INVENTION

The present invention is a data processing method (page 2, line 28) for maintaining and customizing a list of words, phrases, and abbreviations that are standard in a profession, industry, trade or occupation, for automatic insertion of abbreviations from the list into text, for converting selected words and phrases in the text to abbreviations, for converting selected abbreviations in the text into words and phrases, and for automatically converting a number of words and phrases to abbreviations, and abbreviations to words and phrases, throughout the text, comprising the steps of:

a) storing in a memory a first data structure (encoding a plurality of words and corresponding abbreviations; (page 3, line 5)

b) storing in a memory a second data structure encoding a plurality of abbreviations and corresponding words; (page 3, line 7)

c) selecting a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using the first data structure (page 3, line 9); and

d) selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure (page 3, line 12).

VI. ISSUES

1.) Whether or not claims 1-22 are non-obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 5,410,475 (Lu).

VII. GROUPING OF CLAIMS

The rejected claims do not stand or fall together. Claims 13-17 and 18-22 are separately patentable from claims 1-12 for the reasons given below and do not stand or fall together with the other claims.

VIII. ARGUMENT

I. Claims 1-22 are non-obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 5,410,475 (Lu).

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[1] If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.[2]

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.[3]

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

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[1] MPEP Sec. 2142.

[2] Id.

[3] Id. (emphasis supplied)

As to claim 1, Lu does not teach or suggest:

storing in a memory a first data structure encoding a plurality of words and corresponding abbreviations;

storing in a memory a second data structure encoding a plurality of abbreviations and corresponding words;

selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure.

The Office Action is incorrect in stating that Lu discloses selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word. Lu only discloses converting a token (that has been created from a Long Case Name) into an abbreviated version of the Long Case Name, i.e., to a "short case name" (SCN). That is, if the Examiner identifies Lu's Long Case Name (LCN) with the claimed "word" and the Short Case Name (SCN) with the claimed "abbreviation", there is no disclosure in Lu of converting an SCN ("abbreviation") to an LCN ("word"). Lu only works in the direction of converting a "word" to an "abbreviation."

In response to the sections of the '475 patent cited by the Examiner, Appellant notes the following:

> "In the field of computerized text processing, there are numerous applications where "raw" text needs to be processed according to a set of guidelines and/or rules. One particular example of the "raw" text is the full name or the long case name (LCN) of a lawsuit. Typically, lawsuits are referred to by an abbreviated form of the LCN. This abbreviated form is referred to as the short case name (SCN)." Col. 1 lines 22-29 (emphasis supplied)

> "The present invention provides a computerized method and apparatus that transforms a lawsuit's LCN—which is comprised of words, phrases, and punctuation—to an SCN format according to a set of rules...The resulting text is the SCN." Col. 1 lines 50-67.

These passages show that the '475 patent only discloses converting text (the LCN) into an abbreviation (the SCN). Nowhere has the Examiner pointed out any disclosure in the '475 patent of converting the SCN (an abbreviation) into the LCN (text). The citation to col.

6, line 14 to col. 8 lines 1-49 is just "a list of representative tokens which are particularly useful in a specific example of transforming an LCN of a lawsuit into an SCN." (emphasis supplied).

The Examiner is also incorrect in stating that "Lu discloses the text in the memory containing a list of words and correspondent abbreviations (col. 5, lines 20-68; col. 6 line 14 to col. 8 lies 1-49)."

Lu does not have a "list of words and corresponding abbreviations." Instead, Lu converts each LCN by a heuristic into a token. The token is then converted into an SCN. Col. 1 lines 49-67. This method would not work in converting an SCN into an LCN, because there is no disclosure of converting an SCN back into a token, or converting a token back into an LCN. Because the conversion of LCN to tokens actually proceeds in two stages with intermediate culling of inappropriate low-level tokens (col. 1 lines 49-67), there would be no way to convert an SCN back into the LCN from which it was derived without ambiguity. The process as disclosed simply does not work the way the Examiner has described it. It is irreversible.

In addition, the Examiner is taking Official Notice that:

> It would have been obvious to an ordinary skill at the time of the invention was made to have modified Lu to include storing in the memory a first data encoding a plurality of words and corresponding abbreviations and a second data structure encoding a plurality of abbreviations and corresponding words for the following reason. Lu teaching of lists and phrases and corresponding abbreviations suggests storing in the memory two different data structures for two different lists of words and abbreviations. Also, it was well known in the art that once said lists are in the memory, the lists can be displayed for manipulating including selecting an item in the list by a user.

This is impermissible. As noted above, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." The Examiner has not shown where the prior art teaches or suggests making the claimed combination or a reasonable expectation of

success. Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*[4] The MPEP requires the Examiner to do so.[5] However, the Examiner has made no finding of the level of ordinary skill in the art.[6]

Claim 1 is therefore allowable.

Claims 2-14 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

In regard to claims 13-14, the Examiner argues that "Lu discloses an abbreviation in the text to be converted" and cites to col. 4, lines 20-59 as showing converting the abbreviation "IBM" into "International Business Machines." Quite the contrary. According to Lu, "International Business Machines" is converted to "IBM."

Further regarding claims 13-14, the Examiner argues that

> "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Lu to include inserting the abbreviation into the text at a position selected by the user since it was well known in the art to use the cut/copy and paste method or the drag-and-drop method for inserting a selected data into the text at a position selected by the user."

Appellant respectfully argues that the Examiner is using pure hindsight here. Lu is intended to run as a fully automatic method of simply converting (one way only) Long Case Names into Short Case Names. There is no disclosure of: 1) inserting Short Case names into text; or 2) inserting Short Case Names into text at a position selected by a user.

For this reason, Appellant argues that claims 13 and 14 are separately patentable and do not stand or fall together with claim 1.

Claim 15 incorporates the limitations of claims 1 and 13, and should be grouped with claims 13 and 14 as separately patentable and does not stand or fall together with claim 1.

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[4] 383 U.S. 1 (1966)

[5] MPEP § 2141

[6] MPEP § 2141.03

Claim 16 contains additional elements or limitations beyond allowable claim 15 and is also allowable. It should be grouped with claim 15.

Claim 17 is also allowable and should be grouped with claims 13, 14, 15, and 16.

Claims 18-21 contain additional elements or limitations beyond allowable claim 17 and are also allowable. They should be grouped with claim 17.

Claim 22 is independently patentable for the reasons given above in regard to claims 13, 14, and 15 and should be grouped with those claims.

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

IX. APPENDIX

The appealed claims are presented in the attached appendix.

Respectfully submitted,

Dated: 6/17/03

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